

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 107

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DAVID H. KIEL, and KEITH D. CHURCH

Junior Party,
(Patent No. 5,627,932)¹,

v.

LIONELL GRAHAM, JAMES R. HOLMAN,
TERRY D. MATHIS, and MONTRI VIRIYAYUTHAKORN

Senior Party
(Application 08/510,021)².

Patent Interference No. 104,352

Before: McKELVEY, Senior Administrative Patent Judge, and
SCHAFFER and LEE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

¹ Based on application 08/518,211, filed August 23, 1995. The real party in interest is Siecor Technology, Inc.

² Filed on August 1, 1995. The real party in interest is Lucent Technologies Inc.

Interference No. 104,352
Kiel v. Graham

MEMORANDUM OPINION AND JUDGMENT

This interference was declared on February 4, 1999.

Kiel's patent claims 1-20 and Graham's application claims 37-45 were designated as corresponding to the count. Party Kiel has represented to the Board that its claims 1-9 and 11-19 are unpatentable over a 1990 sales Catalogue of Optical cable Corporation ("sales catalogue"), and the Board has found all of Graham's claims 37-45 to be unpatentable over the sales catalogue or, alternatively, the sale of cables shown in the catalogue. (Paper No. 81). In response to our holding of unpatentability against its claims 37-45, party Graham filed a miscellaneous motion (Paper No. 89) for leave to "present claim amendments, new claims, and evidence (including affidavit testimony) responsive to the prior art reference." The motion is opposed by Kiel.

Party Kiel filed preliminary motion 1 for judgment against Graham's claims on grounds other than the sales catalogue reference. (Paper No. 38). Party Kiel filed preliminary motion 2 to redefine the count to remove claim 10 as an alternative in the count and to have designated as not corresponding to the count its claims 10 and 20. (Paper No.

Interference No. 104,352
Kiel v. Graham

38). Party Graham filed a motion for judgment against Kiel's claims (Paper No. 36), a motion to substitute the count (Paper No. 31), a motion to add new claims to its application (Paper No. 42), a further motion to add new claims to its application (Paper No. 46), a motion for judgment against claims 10 and 20 of Kiel's patent for failure of Kiel's specification to disclose the best mode for practicing the claims invention (Paper No. 71), and a motion to correct inventorship.

In a telephone conference, the administrative patent judge suggested to counsel for respective parties that in light of the opposing arguments as to whether Graham is entitled to make amendments and/or present rebuttal evidence in this interference in response to the Board's holding of unpatentability, if the parties can reach settlement as to all other issues, perhaps the Board may be persuaded to enter judgment against party Graham, without prejudice, so that Graham may make amendments or present new evidence before the examiner. Following the telephone conference, the parties conferred and then the following papers were filed:

Paper No. 105 (By Graham) -- "Filing Pursuant to 37 C.F.R. § 1.666" in which it is stated:

Interference No. 104,352
Kiel v. Graham

Pursuant to 37 C.F.R. § 1.666(a), enclosed herewith is a copy of an executed settlement agreement which settles all outstanding matters in the present interference.

Paper No. 106 (By Graham) -- "Graham Withdrawal of Papers" in which it is stated:

In view of the settlement of the present Interference between the parties, Graham hereby withdraws each of its motions (including Graham Preliminary Motions 1-3 and Graham Motion Under 37 C.F.R. § 1.635 of January 27, 2000) with the exception of Graham Motion for Correction of Inventorship. In addition, Graham hereby withdraws Graham Opposition to Corrected Kiel Motion 2. (Emphasis in original.)

Paper No. 104 (By Kiel) -- "Kiel Withdrawal of Corrected Kiel Motion 1" in which it is stated that Kiel withdraws its corrected preliminary motion 1.

It is evident that the parties are attempting to implement the procedure suggested by the administrative patent judge. We presume that party Kiel has no objection to our entering judgment against party Graham without prejudice to Graham's subsequently amending its claims or presenting rebuttal evidence before the examiner.

The only motions now remaining pending are: (1) Kiel's preliminary motion 2, and (2) Graham's motion to correct inventorship. Both are unopposed.

Interference No. 104,352
Kiel v. Graham

Because on this record Graham has no patentable claim which corresponds to the existing count or any count proposed by the parties, it is not necessary to decide Kiel's preliminary motion 2 to redefine the count and to designate its claims 10 and 20 as not corresponding to the count. Accordingly, Kiel's preliminary motion 2 is dismissed as moot.

Because party Kiel has admitted to the unpatentability of its own claims 1-9 and 11-19, we find those claims unpatentable to party Kiel.

It is

ORDERED that judgment is herein entered as follows:

1. Junior party DAVID H. KIEL and KEITH D. CHURCH is not entitled to a patent containing its claims 1-9 and 11-19;

2. On the record before us, senior party LIONELL GRAHAM, JAMES R. HOLMAN, TERRY D. MATHIS, and MONTRI VIRIYAYUTHAKORN is not entitled to its application claims 37-45;

3. The judgment so entered today is without prejudice to the senior party's presenting claim amendments and/or rebuttal evidence to the examiner to attempt to overcome the holding of unpatentability as to its claims 37-45;

Interference No. 104,352
Kiel v. Graham

FURTHER ORDERED that party Graham's unopposed motion to correct inventorship is dismissed, without prejudice to re-filing the same before the examiner; and

FURTHER ORDERED that in further ex parte prosecution before the examiner, the senior party shall bring to the examiner's attention (1) pages 15-20 of our show cause order dated March 8, 2000 (Paper No. 81) in which we discussed the unpatentability of Graham's claims 37-45 over the sales catalogue; (2) Kiel's corrected preliminary motion 1 [now withdrawn] (Paper Nos. 38 and 50) and reply (Paper No. 62) to Graham's opposition; and (3) Graham's preliminary motion 1 [now withdrawn] (Paper No. 36) and reply (Paper No. 65) to Kiel's opposition.

_____)	
FRED E. McKELVEY, Senior)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
_____)	APPEALS
RICHARD E. SCHAFER)	AND
Administrative Patent Judge)	INTERFERENCES
)	

Interference No. 104,352
Kiel v. Graham

_____)
JAMESON LEE)
Administrative Patent Judge)

Interference No. 104,352
Kiel v. Graham

By Federal Express

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